Supreme Court of the United States

OCTOBER TERM 1942.

No. 692

BAND-IT COMPANY, a corporation, and DENTAL SPECIALTY COMPANY, a corporation,
PETITIONERS,

v.

MICHAEL J. McANENY, JR.

PETITION FOR REHEARING.

Come now the above named Petitioners, Band-It Company and Dental Specialty Company, and present this, their petition for rehearing of the above entitled cause, and, in support thereof, respectfully show:

In and by its opinion and judgment (R. 317-323) the Circuit Court of Appeals has attempted to grant to appellee, and has adjudicated, a new patent; a patent which the Patent Office refused to grant; a patent which appellee sought but, being refused, surrendered in the Patent Office; a patent which appellee never claimed during the trial of this case; a patent which was never passed upon by the District Court.

It has attempted to grant appellee a patent which is

so broad that it would be infringed by any tool constructed according to any one of the following claims which were sought in the application for appellee's (the Campbell) patent, rejected by the Patent Office and surrendered by the applicant, namely: claims 1, 2, 3, 4 and 5 (R. 205); claims 6, 7, 9 and 10 (R. 207) and claim 11 (R. 209).

The Circuit Court of Appeals has done this by "reading * * * by construction into claims which are allowed" (claim 1 of the Campbell patent in suit) the substance of ten (out of the original total of eleven) claims sought by applicant, rejected by the Patent Office and surrendered by applicant.

That Court has, thereby, "decided a federal (patent) question in a way * * * in conflict with applicable decisions of this court" (Rule 38 par. 5 (b)).

The most "applicable" decision of this Court, and one of its latest, is *Schriber-Schroth Co. vs. Cleveland Trust Co.*, 311 U. S. 211, cited with excerpts at pages 7-8 of the Brief in Support of Petition for Writ of Certiorari.

The foregoing statements are fully sustained by the parts of the record specifically referred to at pages 6-7 of our said brief which, to avoid repetition, we incorporate here by reference. The record contains nothing to the contrary.

We are mindful that review on writ of certiorari is not a matter of right but of sound judicial discretion and that the writ will be granted only for special and important reasons.

We are also mindful that refusal at this time to grant the writ will not prejudice the presentation of the same questions if and when the case comes here again after accounting and final decree.

We submit, however, that there are special and important reasons for granting this writ.

The District Court found infringement by the particular Band-It tool accused in this case (illustrated in Ex. D, R. 213) because it has "an eccentric member which is per-

manently, though revolubly, fixed within the slide member during all phases of the operation of the tool" and that this eccentric member was a "substitute" for the "open bearings" and the "key to be journaled in the bearings" (R. 19).

(Note. Claim 1 reads—"key bearings on said slide member, an eccentric key *adapted to be journaled in the bearings*" (R. 202). (Italics ours.)

Had the Circuit Court of Appeals affirmed the decree of the District Court on the patent as tried and as thus adjudicated by that Court, even though the holding of mechanical equivalency was erroneous, the litigation would have terminated with a simple accounting for the tools already produced because the Band-It Company could have eliminated all question of infringement by simply adopting some of the band gripping eccentrics shown in the long expired prior art patents of record, such as the cams 21 and 22 of Moock, 1905 (R. 236), the eccentric clamping member 16 of Blake, 1913 (R. 240), the eccentric cam 9 actuated by lever 10 of Whitlock, 1916 (R. 244) or the eccentric clamp jaw 10 of Henrickson, 1920 (R. 248).

In view of the Circuit Court of Appeals opinion, however, when the accounting comes on, McAneny will, of course, claim profits on any kind of a tool of this class which Band-It Company has adopted and is using and a retrial of the question of infringement is almost certain, with a very definite prospect of appeal to the Circuit Court of Appeals and of a petition to this Court for a determination of the same question which is now before this Court, having been presented by the Petition for the Writ of Certiorari.

The desire to avoid burdening the courts (as well as the parties) with this protracted litigation which (from developments subsequent to the making of the record in this case) we foresee as a practical certainty, leads us to urge the exercise of that discretion contemplated by paragraph 5 of Rule 38.

It is respectfully submitted that the opinion of the Circuit Court of Appeals has produced the situation that this

Court had in mind when, in the case of *Schriber-Schroth Co. vs. Cleveland Trust Co., supra,* it said at page 221:

> "THE INJURIOUS CONSEQUENCES TO THE PUBLIC AND TO INVENTORS AND PATENT APPLICANTS IF PATENTEES WERE THUS PERMITTED TO REVIVE CANCELLED AND REJECTED CLAIMS AND RESTORE THEM TO THEIR PATENTS ARE MANIFEST."

For the foregoing reasons it is respectfully urged that this petition for rehearing be granted, and that the judgment of the Circuit Court of Appeals for the Tenth Circuit be, upon further consideration, reversed.

Respectfully submitted,

CARLE WHITEHEAD,
ALBERT L. VOGL,
Counsel for Petitioners.

Signature of individual
CARLE WHITEHEAD,
Counsel.

CERTIFICATE OF COUNSEL.

I, Carle Whitehead, counsel for the above named petitioners, do hereby certify that the foregoing petition for a rehearing of this cause is presented in good faith and not for delay.

CARLE WHITEHEAD,
Counsel for Petitioners.